

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Michael E. McHenry, Irwin)	PATENT APPLICATION
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)	
APPLICATION NO.:	09/829,393)	Group Art Unit: 3625
CONFIRMATION NO.:	8969)	
)	
FILED:	April 10, 2001)	Examiner:
)	Nicholas D. Rosen
)	
FOR:	CUSTOMIZED MOTOR OIL)	Attorney Docket No.:
	SELECTION)	BP9454-00

Appeal Brief

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA
22313-1450

Sir:

This is an appeal from the Final Rejection of Claims 1 to 32 and 34 in the above-identified patent application. A correct copy of the appealed claims is attached to this brief as Claims Appendix.

Real Party in Interest

The instant patent application has been assigned to Castrol Limited.

ANY ADDITIONAL FEES REQUIRED
CHARGE TO DEPOSIT ACCOUNT
NO. 01-0528

Related Appeals and Interferences

None.

Status of Claims

Claims 1 through 32 and 34 remain pending and have been finally rejected by the Examiner. Claim 33 has been canceled. Claim 1, Claim 4, and Claim 23 are independent claims. All of the claims have been rejected in a final rejection mailed August 14, 2006.

Status of Amendments

An amendment was filed October 13, 2006, in response to the final rejection mailed August 14, 2006, in which Claim 4 was amended to put it in independent form and to set forth the limitations of Claim 1 in it, and Claim 23 was amended for purposes of clarification. The Examiner stated in an Advisory Action mailed October 24, 2006, that the amendment filed October 13, 2006, in response to the final rejection of August 14, 2006, would be entered upon appeal but that it did not overcome the Final Rejection so that the status of the claims is that Claims 1-32 and 34 as amended October 13, 2006, are pending and have been finally rejected by the Examiner.

Summary of Claimed Subject Matter

The subject matter of the present invention relates to a method of obtaining motor vehicle engine oil having characteristics desired by a user via using a wide area computer network to enable the engine oil user or customer to participate in the design, selection or customization of a particular motor oil to fit that customer's specific needs. The method enables a motor oil producer to design, produce, and deliver or make available an engine oil which fits a particular customer's individual needs by analyzing information provided by the customer. The customer participates in the design, selection or customization of

a particular motor oil by providing information used to supply an engine oil with characteristics designed to meet that customer's individual needs.

Claim 1 is directed to:

1. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs. (See Appellants' specification at page 5, lines 5-16.)

According to Claim 1 of the present invention, a wide area computer network site is provided which allows a customer, in one of several ways, to participate in the design, selection or customization of a particular motor oil to fit that customer's individual needs. (See Appellants' specification at page 1, lines 14-16.)

Claim 4 is directed to:

4. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in

the design, selection or customization of a particular motor oil to fit that customer's needs. (See Appellants' specification at page 4, line 26 to page 5, line 16 and at page 1, lines 14-16.)

Claim 23 is directed to:

23. A method of obtaining custom engine oil by:

(a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility;

(b) blending a custom engine oil using the information from (a); and

(c) delivering to, installing or making available the custom engine oil blended in step (b) to the user from step (a). (See Appellants' specification at page 7 lines 23-29.)

Step (a) of Claim 23 may be practiced using a telephone, computer network, or prepared document. (See Appellants' specification at page 7 lines 28-29.)

The methods of Claim 1, Claim 4, and Claim 23 permit a motor oil customer to participate in the design, selection or customization of motor oil which has characteristics desired by the motor oil user.

More particularly, data is obtained from the user to identify the user's desired requirements for the motor oil to be obtained. Depending on the particular method of the invention, this data may be obtained using a telephone, computer network, or prepared document. (See Appellants' specification at page 7 lines 28-29.) For example, data may be gathered via a questionnaire displayed on a computer screen and may include information about the motor vehicle in which the engine oil is to be utilized as well as information relating to the environment of use, the operational characteristics desired by the customer, ambient temperature, the customer's average driving distance, the user's normal type of driving, and customer interest in fuel economy, cold weather starting, engine longevity and the ability to extend oil drain intervals. (See Appellants'

specification at page 5 lines 5-19.) The computer screen may also display indicia which enables the user to order other automotive products. (See Appellants' specification at page 7 lines 21-22.) The data is analyzed by a computer and an oil is provided to the user which has the characteristics desired by the user.

The methods of the invention may be practiced to provide a baseline motor oil of from about 5 percent to 99.9 percent of the final customized motor oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant or a blend stability additive. (See Appellants' specification at page 5, line 19 to page 6, line 3.); to provide about 0.1-100% improvement in at least one of fuel economy, wear performance, detergent performance, dispersant performance, oxidation protection, corrosion protection, low temperature performance and blend stability. (See Appellants' specification at page 6, line 17 to page 7, line 10.); to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability (See Appellants' specification at page 5, line 19 to page 7, line 10.); and to); to provide an absolute increase in each of said two or more enhanced features of from about 0.01-10% (See Appellants' specification at page 6, line 17 to page 7, line 10, particularly page 6, line 30 to page 7, line 10.), and to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% for each component compared to their concentration levels in a quality baseline motor oil. (See Appellants' specification at page 7 lines 11-20.). In the methods of the present invention steps (a) – (c) may be practiced using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil. (See Appellants' specification at page 1, line 26 to page 2, line 28.)

Grounds of Rejection to be Reviewed on Appeal

Claims 1-22 and 34

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article, "Ford Issues Car Care Alert," hereinafter "Ford," in view of Osborn et al. (U.S. Patent 6,182,048). The Examiner maintains that as per claim 1, "Ford" discloses (c) providing a motor oil having recommended, or user desired enhancements (three paragraphs beginning from, "(4) Use the proper engine oil") based on (a) data including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements (ibid). The Examiner maintains that "Ford" does not disclose analyzing the data by computer, but that Osborn teaches analyzing motor vehicle related information by computer (column 3, line 27, through column 6, line 35), and that, hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellants' invention to analyze the data by computer, and provide an engine oil responsive to the data analysis, for the obvious advantage of using a computer for calculations that may be difficult or time-consuming for human beings to perform, e.g., involving multivariate linear regression, as taught in Osborn, to provide a motor oil selected on the basis of numerous factors.

The Examiner maintains that as per claim 2, "Ford" discloses basing a decision on type of vehicle, and selecting a lubricant as recommended based on the type of vehicle (three paragraphs beginning from, "(4) Use the proper engine oil").

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford" and Osborn as applied to claim 1 above, and further in view of Wilkinson ("Understanding What's in Your Car's Motor Oil"). The Examiner maintains that Osborn teaches computer analysis based on expected ambient temperatures (column 5, line 61, through column 6, line 35), and that Wilkinson teaches that the advantages of a motor oil depend on ambient temperatures (paragraphs beginning "There are still some backyard chemists" and "The problem? Price.")

and that, hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellants' invention to practice (a) to input at least one of expected ambient temperatures, average driving distance, normal type of driving, and interest in fuel economy, cold weather starting, and engine longevity, for the obvious advantage of providing an engine oil suited to a particular user's needs.

Claims 4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford" and Osborne as applied to claim 1 above, and further in view of Klepacki ("Reflect to Mirror Users"). The Examiner maintains that as per claim 4, the different engine oils in "Ford" can be regarded as customized for different circumstances of use, and that it is well known to make custom blends of mixed materials, as taught, for example, by Klepacki (especially paragraph beginning, "Unlike most beauty e-commerce sites," and the paragraph thereafter; see also remainder of Klepacki article for obtaining input from users, etc.) and that, hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellants' invention for (a)-(c) to be practiced to design, produce, and deliver or make available a customized engine oil, for the obvious advantage (analogous to the advantage achieved in Klepacki) of customizing the oil to best suit a particular user.

The Examiner maintains that as per claim 5 (depending on claim 1), and as per claim 6 (depending on claim 4), Klepacki teaches displaying a questionnaire on a computer screen connected to a global computer network and prompting a user to input information into the questionnaire (three paragraphs beginning from "The degree of customization to be offered"; the computer screen as such being implied by the Web-based questionnaire).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, and Klepacki as applied to claim 6 above, and further in view of official notice. The Examiner concedes that "Ford" does not disclose displaying on the computer screen indicia indicating the ability of the user to order other automotive products, but the Examiner takes official notice that it is well known to display advertising indicia on computer screens. The Examiner maintains that, hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellants' invention to display on the computer screen indicia indicating the ability of the user to order other automotive products, for the

obvious advantage of profiting from the sale of automotive products to persons likely to be interested in buying them.

Claims 8-12, 14, 15, 16, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, and Klepacki as applied to claim 4 above, and further in view of Denis et al. (U.S. Patent 4,954,273). The Examiner concedes that as per claims 8-12, "Ford" is not explicit about the composition of the lubes, but maintains that Denis teaches a customized motor oil containing about 86.24 percent of a baseline motor oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant, or a blend stability additive (Fully Formed Example III, column 13, lines 46-68) and that, hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of Appellants' invention to practice (c) to provide a baseline motor oil of from about 50, 60, 75, or 80 percent to 99.9 percent of the final customized engine oil, and at least one of the listed additives, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

The Examiner maintains that as per claim 14, Denis teaches providing an absolute increase of from about 0.1-10% in at least one selected from the group consisting of fuel economy additives, antiwear additives, detergent additives, dispersant additives, oxidation control additives, corrosion inhibitors, pour point depressants, and blend stability additives (Fully Formed Example III, column 13, lines 46-68) and that, hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of appellants' invention to practice (c) to add additives as listed, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

The Examiner maintains that as per claim 15, Denis teaches providing additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability (Fully Formed Example III, column 13, lines 46-68) and that, hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of Appellants' invention to practice (c) to add additives leading to at least

two or more of the listed enhanced features, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

The Examiner maintains that as per claim 16, Denis teaches adding additives leading to at least three of said enhanced features, making claim 16 obvious on the same grounds as claim 15.

The Examiner concedes that as per claim 21, Denis does not expressly disclose that (c) is practiced to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil, but the Examiner maintains that Denis does teach that "a basic nitrogen containing dispersant" can vary from 1 to 15 weight percent, and "a detergent in the form of an overbased calcium sulfonate" from 0.2 to 3 weight percent (General Formulated Example, column 13, lines 1-21) and that, hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of Appellants' invention to practice (c) to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil, for the obvious advantage of producing a customized engine oil having desired properties.

The Examiner maintains that as per claim 22, Denis discloses variations in both detergent and dispersant levels, as noted above in regard to claim 21.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, Klepacki, and Denis as applied to claims 8-12 above, and further in view of official notice. The Examiner concedes that neither "Ford" nor Denis discloses that (c) is practiced to provide about 0.1-100% percent improvement in at least one of fuel economy, wear performance, detergent performance, dispersant performance, oxidation protection, corrosion protection, low temperature performance and blend stability, but the Examiner maintains that Denis does teach adding additives to improve these characteristics, as set forth above. The Examiner maintains that the reasonable presumption is that one would not go to the trouble of attempting to determine optimal quantities of various additives, and the expense of adding these additives, as taught in Denis and other art of record, unless these additives produced a non-trivial improvement in the properties that they were intended to improve and that one

would hardly identify a chemical as, for example, an antiwear additive unless its effects on preventing wear were detectable without extreme effort, implying an improvement greater than 0.1%. The Examiner takes official notice that the effects of many additives are, within a range, dependent on concentration, so that, even if the improvement were over 100% under some circumstances, a lower concentration would produce an improvement of less than 100% -- and, indeed, it might be that no concentration of an additive would improve performance by more than 100% over a baseline oil and argues that, hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of Appellants' invention to practice (c) to provide about 0.1-100% improvement in at least one of the listed characteristics, as an obvious consequence of adding desirable additives as taught by Denis.

Claims 17, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, Klepacki, and Denis as applied to claims 15 and 16 above (to claim 15 in the case of claims 17 and 19; to claim 16 in the case of claims 18 and 20), and further in view of official notice. The Examiner maintains that these claims are essentially parallel to claim 13, and rejected on essentially the same grounds.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford" and Osborn as applied to claim 1 above, and further in view of the admitted prior art. The Examiner concedes that "Ford" does not disclose practicing steps (a) - (c) using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil, but argues that the instant application teaches that there are accepted industry standard practices outlined in codes introduced by industry organizations such as the American Chemistry Council and the Technical Committee of Petroleum Additive Manufacturers in Europe (page 2, lines 13-24). The Examiner maintains that, hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of Appellants' invention to practice (a) - (c) using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil, for the obvious advantages of benefiting by the accumulated knowledge of the industry, and being able to cite compliance to standard performance credentials as a defense in the event of product liability suits.

Claims 23-32

Claims 23, 24, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klepacki ("Reflect to Mirror Users") in view of Wilkinson ("Understanding What's in Your Car's Motor Oil"), the anonymous article, "Drive Green Tips," and official notice. The Examiner maintains that as per claim 23, Klepacki discloses obtaining a custom product by: (a) using an implement to transmit information from a user to a customized blending facility; and (b) blending a custom product using the information from (a) (two paragraphs beginning from, "Unlike most beauty e-commerce sites," and three paragraphs beginning from, "The degree of customization to be offered"). The Examiner concedes that Klepacki does not disclose that the information is information about a user's motor vehicle type, environment of use, and desired operational characteristics, but maintains that Wilkinson teaches selecting an engine oil based on environment of use (the two paragraphs beginning from "What Experts Recommend," and the two paragraphs from "There are still some backyard chemists"), and motor vehicle type (paragraph beginning "Ask any engine engineer at a car company"), while "Drive Green Tips" teaches a motor oil affecting desired operational characteristics (paragraph beginning, "If the Owner's Guide recommends"). The Examiner maintains that, hence, it would have been obvious to one of ordinary skill in the art of electronics at the time of Appellants' invention to transmit this information, and to blend an engine oil accordingly, for the obvious advantage of providing a suitable product in accordance with a user's particular needs.

The Examiner concedes that Klepacki does not expressly disclose (c) delivering to, installing, or making available for pickup by a user the custom product from (b), but takes official notice that it is well known for e-commerce websites to deliver or make available products ordered by users. The Examiner maintains that, hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellants' invention to deliver to, install, or make available for pickup by a user the custom engine oil, for the obvious advantage of giving a user reason to participate in the website, and pay for the ordered product.

The Examiner maintains that as per claim 24, Klepacki discloses that (a) is practiced using a telephone, computer network, or prepared document; as per

claim 25, Klepacki discloses that (a) is practiced using a global computer network; and as per claim 26, Klepacki discloses electronically displaying a questionnaire on a computer screen connected to a global computer network and prompting a user to input information into the questionnaire (three paragraphs beginning from "The degree of customization to be offered"; the computer screen as such being implied by the Web-based questionnaire).

Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klepacki, Wilkinson, "Drive Green Tips," and official notice applied to claim 23 above, and further in view of Denis et al. (U.S. Patent 4,954,273). The Examiner concedes that as per claim 27, neither Klepacki nor Wilkinson discloses that blending a custom engine oil is practiced to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability, but maintains that Denis teaches adding additives to enhance two or more of these features (Fully Formed Example III, column 13, lines 46-68). The Examiner maintains that hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of Appellants' invention to practice (b) to add additives leading to at least two or more of the listed enhanced features, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

The Examiner maintains that as per claim 28 Denis teaches adding additives to enhance three or more of the listed features (Fully Formed Example III, column 13, lines 46-68), making claim 28 obvious on the same grounds as claim 27.

The Examiner maintains that as per claims 29-32, Denis teaches a customized motor oil containing about 86.24 percent of a baseline motor oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant, or a blend stability additive (Fully Formed Example III, column 13, lines 46-68) and that, hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of Appellants' invention to practice (c) to provide a baseline motor oil of from about 50, 60, 75, or 80 percent to 99.9

percent of the final customized engine oil, and at least one of the listed additives, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

Argument

Rejection Under 35 USC § 103(a) of Claims 1-3, 6 and 7

Claims 1 and 2

Claim 1 and 2 were rejected under 35 USC 103(a) as being unpatentable over the anonymous article "Ford Issues Car Care Alert" ("Ford") in view of Osborn et al. (U. S. Patent 6,182,048).

The Examiner has the burden of establishing a prima facie case of obviousness. In order to establish obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. (see MPEP 706.02(j)).

The Examiner has not established a prima facie case of obviousness because the prior art does not teach or suggest all of the claim limitations since:

1) None of the references teach or suggest providing motor oil having user desired characteristics for an individual consumer by analyzing information provided by the consumer, thus allow the customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs;

2) There is no suggestion or motivation to modify the Ford reference to analyze motor vehicle information by computer since Ford does not address providing motor oil for an individual but is merely a news article with suggestions on winter car care, one of which is that motorists use a certain weight oil in winter; and

3) There is nothing in Ford that would suggest analyzing data in order to provide a motor oil to meet a particular consumer's desires based on a computer analysis of data input by the individual consumer.

Ford lacks all of the elements of Claim 1. Ford does not:

- a) obtain and input data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyze the data obtained from a user by computer; or
- (c) responsive to the analysis of the data provide a motor vehicle engine oil having recommended, or user desired enhancements.

Ford merely advises that motorists use a certain weight of a standard motor oil in cold weather. There is no interaction between the customer and the supplier in which the customer provides information to be used to provide an oil having characteristics desired by the customer. Ford merely provides a suggestion to motorists to use the proper engine oil and says that most manufacturers of vehicles specify 5w-30 oil but that vehicle owners should check their owner guides for specific oil recommendations. There is no suggestion in Ford of providing a motor oil to a motorist based on data supplied by the motorist, which has been analyzed by computer to enable the provider to provide a motor oil with characteristics designed for that particular user.

Osborn is not directed to motor oils at all. Osborn is directed to a system and method for providing risk-based pricing for vehicle warranties. Osborn is gathering data in order to enhance the profit on warranties being sold by determining what a profitable price will be. Osborn may collect data about the vehicle to be covered by the warranty, but it is for the purpose of analyzing risk to a warranty seller and for determining the price a seller of warranties will charge to make the profit it wants and not for providing a custom motor oil for the car. Osborn may collect data but not for the purpose of allowing the consumer to design his own motor oil. Osborn does not provide the customer with any choices. Everything Osborn does is primarily for the benefit of the warranty seller, not for the benefit of the car owner. The Osborn warranty seller is gathering information for its own benefit in order to fix a profitable price which the seller will charge the customer for a warranty.

The Examiner relies on Osborn to argue that step (b) of Appellants' Claim 1 is obvious. As mentioned previously, Osborn is directed to a system and

method for providing risk-based pricing for vehicle warranties. The Examiner relies on Osborn as evidence that data related to vehicles is collected and analyzed by computer. Osborn does not collect data for the purpose of allowing the consumer to design his own motor oil or even his own warranty. The invention must be considered as a whole and cannot be found obvious because the Examiner claims that individual steps, similar to those in the claimed invention, may be known. At the time the present invention was made, it was not known or obvious to obtain data from consumers to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs. Ford does not deal with providing motor oil to a user at all, and neither does Osborn.

Ford and Osborn together do not teach or suggest all limitations of Claims 1 and 2. Neither Ford nor Osborn suggests a method for permitting a consumer to obtain motor vehicle engine oil having characteristics desired by the consumer by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

The fact that computers can do calculations would not suggest to someone to combine Ford and Osborn without using hindsight with Appellants' specification before him, which is impermissible.

A prima facie case of obviousness has not been made as Ford and Osborn together do not teach or suggest all limitations of Claims 1 and 2.

Claim 3

Claim 3 was rejected under 35 USC 103(a) as being unpatentable over Ford and Osborn as applied to claim 1 and further in view of Wilkinson ("Understanding What's in your Car's Motor Oil").

The Examiner states that Wilkinson was relied upon for the teaching that the advantages of an motor oil depend on ambient temperatures, making it obvious in view of the other cited references to input information including at least one of expected ambient temperatures, average driving distance, normal type of driving, and interesting fuel economy, cold weather starting, and engine longevity for the advantage of providing an engine oil suited to a particular user's needs.

For the reasons stated previously Appellants submit that Ford and Osborn together do not teach or suggest all limitations of Claim 3 as neither Ford nor Osborn suggests a method for obtaining motor vehicle engine oil which includes permitting a consumer to participate in the design, selection or customization of a motor oil to fit that consumer's needs by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

Wilkinson merely describes some characteristics of known motor oil additives and the recommendation to use different viscosity motor oils for cold temperature driving and warm temperature driving. Wilkinson does not describe analyzing data input by a consumer or providing a motor oil with user desired characteristics based on such data, and, as stated above, Osborn is not directed to motor oils at all and neither Osborn nor Ford suggest providing custom motor

oils. Osborn may collect data but not for the purpose of allowing the consumer to design his own motor oil. The data is collected for a warranty seller's benefit, to enhance the profitability of the warranties.

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. A prima facie case of obviousness has not been made as Ford, Osborn and Wilkinson together do not teach or suggest all the limitations of Claim 3

Claim 6

Claim 6 was rejected under 35 USC 103(a) as being unpatentable over Ford and Osborn as applied to claim 1 and further in view of Klepacki ("Reflect to Mirror Users").

Ford is merely an article in which a Ford Motor Company representative provides advice to motorists on winter car care, including the advice to use 5W-30 motor oil in certain Ford passenger car engines.

Osborn does not relate to motor oils, but to a system and method for providing risk-based pricing for vehicle warranties. Osborn does not collect data for the purpose of allowing the consumer to design his own motor oil or even his own warranty. Osborn does not provide the customer with any choices. Everything Osborn does is primarily for the benefit of the warranty seller, not for the benefit of the car owner. The Osborn warranty seller is gathering information for its own benefit in order to fix a profitable price which the seller will charge the customer for a warranty.

Klepacki relates to cosmetics, skin care, and hair care products not to motor oils or automobiles. There is no mention of "lubrication needs" in Klepacki, and Appellants submit that Klepacki is not analogous art.

For the reasons stated previously Appellants submit that Ford and Osborn together do not teach or suggest all limitations of Claim 6. Neither Ford nor Osborn suggests a method for permitting a consumer to participate in the design of a customized motor oil to fit that consumer's needs by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

Klepacki does not relate to automobiles and motor oils and it is submitted that Klepacki is improperly combined with Ford and Osborn and that one skilled in the art at the time the invention was made would not look to Klepacki, or to Osborn for that matter, in regard to a method for providing customized motor oils. There is no suggestion in Klepacki or Osborn of permitting a consumer to participate in the design, selection or customization of a customized motor oil and there would be no motivation to combine Klepacki, which relates solely to cosmetics, with Ford and Osborn in an attempt to reconstruct Appellants' claimed invention.

Claim 7

Claim 7 was rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, and Klepacki as applied to claim 6 and further in view of official notice. Official notice was taken by the Examiner that it is well known to display advertising indicia on computer screens.

The Examiner argues that it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellants' invention to display on the computer screen indicia indicating the ability of the user to order other automotive products, for the obvious advantage of profiting from the sale of automotive products to persons likely to be interested in buying them.

The Examiner concedes that "Ford" does not disclose displaying on the computer screen indicia indicating the ability of the user to order other

automotive products. Ford is merely a news article providing advice on winter car care. Ford does not describe analyzing data input by a consumer or providing a customized motor oil based on such data and, as stated previously, neither Klepacki nor Osborn relates to motor oils. There is no suggestion in Klepacki or Osborn of permitting a consumer to participate in the design, selection or customization of a customized motor oil and there would be no motivation to combine Klepacki, which relates solely to cosmetics, with Ford and Osborn in an attempt to reconstruct Appellants' claimed invention. Moreover, while it may be known to display advertising indicia on computer screens, it was not known or obvious at the time the present invention was made to obtain data from consumers to permit them to participate in the design, selection or customization of a motor oil to fit their individual needs. The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Ford, Osborn, and Klepacki, together with the Examiner's official notice do not teach or suggest all limitations of Claim 7, and, therefore, a prima facie case of obviousness has not been made.

Rejection Under 35 USC § 103(a) of Claims 4, 5, 8-22 and 34

Claim 4 and 5

Claims 4 and 5 were rejected under 35 USC 103(a) as being unpatentable over Ford and Osborn as applied to claim 1 and further in view of Klepacki ("Reflect to Mirror Users"). Claim 4 has been amended to put it in independent form and to incorporate the provisions of Claim 1 so that Claim 4 pertains to a method wherein the steps (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil.

Ford is merely an article in which a Ford Motor Company representative provides advice to motorists on winter car care, including the advice to use 5W-30 motor oil in certain Ford passenger car engines. There is no suggestion in Ford of customizing an oil to impart characteristics desired by a particular user who had supplied data to provide the basis for designing a customized motor oil for that particular user.

Osborn does not relate to motor oils, but to a system and method for providing risk-based pricing for vehicle warranties.

Klepacki is an article about a proposed beauty e-commerce site for cosmetics, skin care, and hair care products, such as shampoo, which are made to order, based on an individual's preferences. Klepacki relates to cosmetics, skin care and hair care products. Klepacki does not relate to motor oils or automobiles. There is no mention of "lubrication needs" in Klepacki, and Appellants submit that Klepacki is nonanalogous art and is not properly combined with Ford and Osborn as it in no way relates to automobiles or motor oils.

For the reasons stated above Appellants submit that Ford and Osborn together with Klepacki do not teach or suggest all limitations of Claims 4 and 5. Neither Ford nor Osborn suggests a method for permitting a consumer to participate in the design of a customized motor oil to fit that consumer's needs by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

Klepacki relates to cosmetics, not motor oil. Klepacki does not teach or suggest a method for permitting a consumer to participate in the design, selection or customization of a customized motor oil to fit that consumer's particular needs. Neither Ford nor Osborn, alone or in combination with Klepacki, suggests a method for designing, producing and delivering or making available a motor vehicle engine oil which includes permitting a consumer to

participate in the design, selection or customization of a customized motor oil to fit that consumer's needs:

Without having Appellants' specification before him, one would not be motivated to combine Klepacki, Ford and Osborn to reconstruct Appellants' claimed invention. Since there is no motivation to combine these references it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Appellants' specification as a blueprint in an attempt to reconstruct Appellants invention from isolated pieces of the prior art.

The motivation for combining references must come from the prior art, not Appellants' specification. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." In re Lee, 277 F.3d at 1343, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). See In re Dow Chem. Co., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988) ("[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Appellants' disclosure"). Using an Appellants' disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of § 103 which requires judging obviousness at the point in time when the invention was made. See Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. The invention must be considered as a whole. Appellants submit that the subject matter as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made. A prima facie case of obviousness has not been made as Ford, Osborn, and Klepacki together do not teach or suggest all limitations of Claims 4 and 5.

Claims 8-12, 14, 15, 21, and 22

Claims 8-12, 14, 15, 16, 21, and 22 were rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, and Klepacki as applied to claim 4 and further in view of Denis et al. (U.S. Patent 4,954,273).

Claims 8-12

With regard to Ford, it is Appellants' position that Ford does not pertain to custom blended oil but is merely a winter car care news items which suggests the use of a certain weight oil in winter which may be any known oil available from any company. Ford does no more than provide a suggestion to motorists to use the proper engine oil and says that most manufacturers of vehicles specify 5w-30 oil but that vehicle owners should check their owner guides for specific recommendations. There is no suggestion in Ford of customizing an oil to impart characteristics desired by a particular user who had supplied data to provide the basis for designing a customized motor oil for that particular user.

The Examiner concedes that Ford is not explicit about the composition of the lubricants, but argues that Denis teaches a customized motor oil containing various additives.

Denis relates to crank case oil formulations having therein overbased salts of iso-stearyl/pentaethylene glycol-acetic acid which provide improved high temperature performance regarding detergency. Denis does not teach a "customized motor oil," tailored to the individual needs of a consumer but an over-based salt additive for crankcase oils. Denis merely describes a fully blended crankcase oil with a slate of additives. Appellants are not claiming the composition of the motor oil but a method of obtaining a customized motor oil to suit a specific consumer's needs.

As discussed above, Osborn relates to automobile warranties, and Klepacki relates to cosmetics. Neither Osborn nor Klepacki relates to motor oils. Ford merely provides advice to motorists to choose the proper weight oil for winter, and Denis relates to crank case oil formulations containing overbased salts of iso-stearyl/pentaethylene glycol-acetic acid. One would not be motivated

to combine Klepacki, Ford, Osborn, and Denis to achieve Appellants' claimed invention. None of the cited references alone or in combination disclose:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

The invention must be considered as a whole. Appellants submit that he subject matter as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made. Ford, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claims 8-12, and, therefore, a prima facie case of obviousness has not been made.

Claims 14, 15, 16, and 21

With regard to Claims 14, 15, 16, and 21 the Examiner argues that, regarding claim 14, Denis teaches in Example III providing an absolute increase of from about 0.1-10% in at least one selected from the group consisting of fuel economy additives, antiwear additives, detergent additives, dispersant additives, oxidation control additives, corrosion inhibitors, pour point depressants and blend stability additives and that it would have been obvious to practice step (c) of Appellants' claimed invention to add additives as listed for the advantages of producing increased fuel economy, reduced wear, etc. The Examiner advances similar arguments regarding Claim 15, saying that Denis teaches adding additives to motor oils to produce two or more enhanced features, regarding Claim 16, that Denis teaches adding additives leading to at least three of said enhanced features. Regarding Claim 21, the Examiner concedes that Denis does not expressly disclose that (c) is practiced to change at least one of

detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil, but argues that Denis does teach that “a basic nitrogen containing dispersant” can vary from 1 to 15 weight percent and that “a detergent in the form of an overbased calcium sulfonate” from 0.2 to 3 weight percent and that it would have been obvious to practice Appellants' step (c) to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil to produce a customized engine oil having desired properties.

The claimed invention must be considered as a whole. The Examiner cites Denis to demonstrate that a variety of additives are known and are used in varying concentrations to obtain different properties in a motor oil; however, the fact that motor oils can contain additives which provide certain properties is not relevant to an analysis of the claimed invention as a whole. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a consumer's needs. The invention described and claimed in the present application is directed to a method of doing business. The method permits the direct involvement of the consumer when designing a motor oil to suit that particular consumer's individual needs. This business method is not obvious.

As stated previously, Osborn relates to automobile warranties. Klepacki relates to cosmetics. Neither Osborn nor Klepacki relates to motor oils. Ford merely provides advice to motorists to choose the proper weight standard oil for winter. One would not be motivated to combine Klepacki, Ford, Osborn, and Denis to achieve Appellants' claimed invention. None of the cited references alone or in combination disclose:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and

(c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

The invention must be considered as a whole. Appellants submit that the subject matter as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made. Ford, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claims 14, 15, 16, and 21, and, therefore, a prima facie case of obviousness has not been made.

Claim 13

Claim 13 was rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, Klepacki and Denis as applied to claims 8-12 and further in view of official notice that the effects of many additives are, within a range, dependent on concentration. The Examiner concedes that neither Ford nor Denis discloses that (c) is practiced to provide about 0.1 -100% improvement in at least one of fuel economy, wear performance, detergent performance, dispersant performance, oxidation protection corrosion protection, low temperature performance and blend stability, but that Denis teaches additives to improve these characteristics. The Examiner then takes official notice that the effects of many additives are, within a range, dependent on concentration, so that, even if the improvement were over 100% under some circumstances, a lower concentration would produce an improvement of less than 100% -- and indeed, it might be that no concentration of an additive would improve performance by more than 100% over a baseline oil and argues that it would have been obvious to practice (c) to provide about 0.1-100% improvement in at least one of the listed characteristics as a consequence of adding desirable additives as taught by Denis.

With regard to the Examiner's taking of official notice that the effects of many additives are, within a range, dependent on concentration, Appellants do

not agree that the Examiner's statements of "common knowledge" or "well-known in the art" are in fact prior art. The Examiner relies heavily and improperly on official notice of "common knowledge" or "well-known prior art" to fill the gaps in his argument in an attempt to create a prima facie case of obviousness; however, the Examiner does not provide evidentiary support for such arguments. The articles recited by the Examiner to support the official notice that the effects of many additives are, within a range, dependent on concentration do not even relate to additives to engine oil. Marti relates to the use of phyto-additive ingredients, which are herbal and plant extracts, in cosmetics. Zambiasi does not even relate to additives but describes the role of endogenous lipid components on vegetable oil stability. Lustig relates to a building material additive comprising a dispersion of a hydro-phobic substance completely wetted by a surfactant, and a water-soluble polymer, and Kay relates to an accelerator used to increase the vulcanization rate of rubber. None of these support the Examiner's contention that the effects of many additives are, within a range, dependent on concentration in relation to the subject matter of the present invention.

Appellants request that the Examiner produce a proper authority for "taking official notice that the effects of many motor oil additives are, within a range, dependent on concentration, so that, even if the improvement were over 100% under some circumstances, a lower concentration would produce an improvement of less than 100% -- and indeed, it might be that no concentration of an additive would improve performance by more than 100% over a baseline oil and argues that it would have been obvious to practice (c) to provide about 0.1-100% improvement in at least one of the listed characteristics as a consequence of adding desirable additives as taught by Denis."

The invention must be considered as a whole. One would not be motivated to combine Klepacki, Ford ,Osborn, and Denis even along with the Examiner's taking of official notice that the effects of many additives are, within a range, dependent on concentration to achieve Appellants' claimed invention. For the reasons stated above and in the discussion of Claims 14, 15, 16, and 21,

Appellants submit that Ford, Osborn, Klepacki and Denis, even together with the Examiner's official notice, do not teach or suggest all limitations of Claim 13, and, therefore, a prima facie case of obviousness has not been made.

Claims 17, 18, 19, and 20

Claims 17, 18, 19, and 20 were rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, Klepacki and Denis as applied to claim 15 in the case of claims 17 and 19 and to claim 16 in the case of claims 18 and 20 and further in view of official notice.

As discussed previously Ford does not pertain to custom blended oil, but merely advises the use of a proper weight standard oil in winter.

Osborn does not relate to motor oils at all but to a system and method for providing risk-based pricing for vehicle warranties and any data collected about a vehicle is for the purpose of analyzing risk and pricing warranties, not for the purpose of allowing a consumer to make choices to design his own motor.

Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils, and while Dennis may show that additives are known and are used to obtain different properties in a motor oil, that is not relevant to an analysis of the claimed invention, which is not a motor oil but a method for permitting a consumer to participate in the design of a customized motor oil.

Klepacki does not relate to motor oils at all, but is directed to an e-commerce cosmetics site wherein cosmetics and hair care products can be made to order based on an individual's preferences. There is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized motor oil, and there would be no motivation to combine Klepacki with Ford, Denis, and Osborn as well as with the Examiner's taking of official notice that the effects of many additives are, within a range, dependent on concentration, in an attempt to reconstruct Appellants' claimed invention, without using hindsight, which is clearly impermissible.

The official notice taken with regard to Claims 17, 18, 19, and 20 is the same as that applied for Claim 13, that the effects of many additives are, within a range, dependent on concentration, and, for the reasons given previously,

Appellants submit that this is not supported by the references cited by the Examiner and request that the Examiner provide proper authority for the official notice.

Since there is no motivation to combine "Ford", Osborn, Klepacki and Denis as well as the official notice that the effects of many additives are dependent on concentration, it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Appellants' specification as a blueprint in an attempt to reconstruct Appellants' invention from isolated pieces of the prior art. It is well established that such use of hindsight is impermissible.

The invention must be considered as a whole. For the reasons stated above and in the discussion of Claims 13, 14, 15, 16, and 21, Appellants submit that Ford, Osborn, Klepacki and Denis, together with the Examiner's official notice, do not teach or suggest all limitations of Claims 17, 18, 19, and 20. Therefore, a prima facie case of obviousness has not been made.

Claim 34

Claim 34 was rejected under 35 USC 103(a) as being unpatentable over Ford and Osborn as applied to claim 1 and further in view of the disclosure in the present application at page 2, lines 13-24 that there are accepted industry standard practices outlined in codes introduced by industry organizations such as the American Chemistry Council and the Technical Committee of Petroleum Additive Manufacturers in Europe.

The Examiner argues that it would have been obvious to practice (a) –(c) using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil.

Appellants respectfully traverse this rejection. As pointed out above, the invention must be considered as a whole and cannot be found obvious because individual steps may be known. One would not be motivated to combine Ford and Osborn to achieve the invention of Claim 34, even with the information obtained from Appellants' specification that there are accepted industry standard practices outlined in codes introduced by industry organizations. The requisite

motivation to combine references must come from the prior art, not applicant's specification. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure. Neither Ford nor Osborn suggests a method for permitting a consumer to obtain motor vehicle engine oil having characteristics desired by the consumer by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

For the reasons stated above, Ford and Osborn, together with the disclosure in the present application that accepted industry standards exist, do not teach or suggest all the limitations of Claim 34. Therefore, a prima facie case of obviousness has not been made.

Rejection Under 35 USC § 103(a) of Claims 23 to 32

Claims 23, 24, 25, and 26

Claims 23, 24, 25, and 26 were rejected under 35 USC 103(a) as being unpatentable over Klepacki in view of Wilkinson ("Understanding What's in Your Car's Motor Oil"), the anonymous article "Drive Green Tips" and official notice.

Independent Claim 23 relates to:

A method of obtaining custom engine oil by:

- (a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility;
- (b) blending a custom engine oil using the information from (a); and

(c) delivering to, installing or making available for pickup by the user from step (a) the custom engine oil blended in step (b).

As stated previously, Klepacki does not relate to motor oils at all but to cosmetics and hair care products. Klepacki is an article about a proposed beauty e-commerce site for cosmetics, skin care, and hair care products, such as shampoo, which are made to order, based on an individual's preferences.

Wilkinson merely describes some characteristics of known motor oils and their additives and the fact that different viscosity oils are typically recommended for cold temperature performance and warm temperature performance. Wilkinson does not describe analyzing data input by a consumer or providing a customized motor oil based on such data, and the anonymous article "Drive Green Tips" merely advises vehicle owners that they should follow the manufacturers recommendations for scheduled oil and filter changes and that if their Owner's Guide recommends 5w-30 motor oil, they should use it on a regular basis and states that it provides a small fuel economy benefit over 10W40 and 20W40 motor oils. The 5w-30 oil recommended could be any standard 5w-30 motor oil available off the shelf in a store, including a standard "high-quality" oil. Neither Wilkinson nor "Drive Green Tips" suggests a method of obtaining a custom engine oil which permits a consumer to participate in the design of a customized motor oil having operational characteristics desired by that consumer. Nor does Klepacki, which does not relate to engine oils but to cosmetics, suggest a method of obtaining a custom engine oil which permits a consumer to participate in the design of a customized engine oil to fit that consumer's particular needs.

The Examiner concedes that Klepacki does not expressly disclose delivering to, installing, or making available for pickup by a user a custom product, but takes official notice that it is well known for e-commerce websites to deliver or make available products ordered by users. Even if that were the case, The invention must be considered as a whole and cannot be found obvious because individual steps may be known.

Furthermore, the Examiner does not provide any evidence to support the taking of official notice that it is well known for e-commerce websites to deliver or make available products ordered by users. Appellants request that the Examiner produce authority for his statement. If the information relied upon by the Examiner is in fact common knowledge then the Examiner should provide evidentiary support for such arguments.

Klepacki does not even relate to engine oil, and there is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized engine oil. There would be no motivation to combine Klepacki, which does not relate to engine oils, with Wilkinson and "Drive Green Tips" in an attempt to reconstruct Appellants' claimed invention. Since there is no motivation to combine these references it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Appellants' specification as a blueprint in an attempt to reconstruct Appellants' invention from isolated pieces of the prior art which is impermissible.

Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest a method of obtaining custom engine oil by:

- (a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility;
- (b) blending a custom engine oil using the information from (a); and
- (c) delivering to, installing or making available for pickup by the user from step (a) the custom engine oil blended in step (b).

Appellants submit that the subject matter of Claim 23 as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made. Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make

available products ordered by users do not teach or suggest all the limitations of Claim 23. Therefore, a prima facie case of obviousness has not been made.

With regard to the rejection of Claims 24, 25, and 26, Appellants again point out that the invention must be considered as a whole and cannot be found obvious because individual steps may be known. One skilled in the art at the time the invention was made would not have been motivated to combine Klepacki, Wilkinson, the anonymous article "Drive Green Tips" and the Examiner's official notice that e-commerce websites deliver or make available products ordered by users to achieve Appellants' claimed invention. For the reasons stated above in relation to Claim 23, Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claims 24, 25, and 26. Nothing in them alone or in combination suggests a method of obtaining custom engine oil which permits a consumer to participate in the design of a customized engine oil which is blended to fit that particular consumer's needs based on information provided by the customer. Therefore, a prima facie case of obviousness has not been made.

Claims 27-32

Claims 27-32 were rejected under 35 USC 103(a) as being unpatentable over Klepacki in view of Wilkinson, "Drive Green Tips" and official notice applied to Claim 23 above and further in view of Denis et al. (U.S. Patent 4,954,273).

As discussed previously, the Examiner provides no evidentiary support for the taking of official notice that it is well known for e-commerce websites to deliver or make available products ordered by users, and Appellants request that such evidentiary support be provided.

The Examiner concedes that neither Klepacki nor Wilkinson discloses that blending a custom engine oils is practiced to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain

capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability, but argues that Denis teaches adding additives to enhance two or more of these features in Fully Formed Example III and that it would have been obvious to practice (b) to add additives leading to at least two or more of the listed enhanced features.

Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils. The Examiner cites Denis to demonstrate that a variety of additives are known and are used to obtain different properties in a motor oil, but that is not relevant to an analysis of the claimed invention. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a particular consumer's needs. The consumer may not tailor the crankcase oil of Denis to suit his individual needs. Denis merely describes a fully blended crankcase oil with a slate of additives. Nothing in Denis suggests a method of obtaining a customized motor oil to suit a specific consumer's needs.

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. For the reasons stated previously in responding to the rejection of Claims 23-26, Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claims 27-32. Nothing in them alone or in combination with Denis suggests a method of obtaining custom engine oil by: (a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility; (b) blending a custom engine oil using the information from (a); and (c) delivering to, installing or making available for pickup by the user from step (a) the custom engine oil blended in step (b). Therefore, a prima facie case of obviousness has not been made.

Conclusions

Fore the foregoing reasons, Appellants submit that the claims on appeal are patentable because the Examiner failed to establish a prima facie case of obviousness because the references do not teach or suggest all of the claim limitations of the claims on appeal. When Appellants' claimed invention is considered as a whole, it is not obvious in view of the references combined and applied by the Examiner.

Appellants respectfully request the allowance of the claims on appeal.

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Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mary Jo Kanady", is written over a horizontal line.

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Claims Appendix

Claims

1. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

2. A method as in claim 1, wherein (a) is practiced to input only information about at least one of the environment of use, desired operational characteristics and type of vehicle and (b) is practiced to recommend an engine oil based upon at least one of environmental and desired operational characteristics and the type of vehicle data.

3. A method as in claim 2, wherein (a) is practiced to input at least one of expected ambient temperatures, average driving distance, normal type of driving, and interest in fuel economy, cold weather starting, and engine longevity.

4. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

5. A method as in claim 4, wherein (a) is practiced by displaying a questionnaire on a computer screen connected to a wide area computer network, and prompting a user to input information into the questionnaire.

6. A method as in claim 1, wherein (a) is practiced by displaying a questionnaire on a computer screen connected to a global computer network, and prompting a user to input information into the questionnaire.

7. A method as in claim 6, further comprising displaying on the computer screen indicia indicating the ability of the user to order other automotive products.

8. A method as in claim 4, wherein (c) is further practiced to provide a baseline motor oil of from about 5 percent to 99.9 percent of the final customized engine oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant or a blend stability additive.

9. A method as in claim 8, wherein (c) is further practiced to provide a baseline motor oil of from about 50 percent to 99.9 percent of the final customized engine oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant or a blend stability additive.

10. A method as in claim 8, wherein (c) is further practiced to provide a baseline motor oil of from about 60 percent to 99.9 percent of the final customized engine oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant or a blend stability additive.

11. A method as in claim 8, wherein (c) is further practiced to provide a baseline motor oil of from about 75 percent to 99.9 percent of the final customized engine oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant or a blend stability additive.

12. A method as in claim 8, wherein (c) is further practiced to provide a baseline motor oil of from about 80 percent to 99.9 percent of the final customized engine oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant or a blend stability additive.

13. A method as in any one of claims 8, 9, 10, 11, or 12, wherein (c) is further practiced to provide about 0.1-100% improvement in at least one of fuel economy, wear performance, detergent performance, dispersant performance, oxidation protection, corrosion protection, low temperature performance and blend stability.

14. A method as in any one of claims 8, 9, 10, 11, or 12, wherein (c) is further practiced to provide an absolute increase of from about 0.1-10% in at least one selected from the group consisting of fuel economy additives, antiwear additives, detergent additives, dispersant additives, oxidation control additives, corrosion inhibitors, pour point depressants and blend stability additives.

15. A method as in claim 4, wherein (c) is practiced to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability.

16. A method as in claim 15, wherein (c) is practiced to add additives leading to at least three or more of said enhanced features.

17. A method as in claim 15, wherein (c) is further practiced to provide an absolute increase in each of said two or more enhanced features of from about 0.01-10%.

18. A method as in claim 16, wherein (c) is further practiced to provide an absolute increase in each of said three or more enhanced features of from about 0.01-10%.

19. A method as in claim 15, wherein (c) is further practiced to provide an improvement in each of said two or more enhanced features of from about 0.01-100%.

20. A method as in claim 16, wherein (c) is further practiced to provide an improvement in each of said three or more enhanced features of from about 0.01-100%.

21. A method as in claim 4, wherein (c) is further practiced to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% for each component compared to their concentration levels in a quality baseline motor oil.

22. The method of claim 21, wherein both of said detergent and dispersant concentration levels are changed.

23. A method of obtaining custom engine oil by: (a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility; (b) blending a custom engine oil using the information from (a); and (c) delivering to, installing or making available for pickup by the user from step (a) the custom engine oil blended in step (b).

24. A method as in claim 23, wherein (a) is practiced using a telephone, computer network, or prepared document.

25. A method as in claim 24, wherein (a) is practiced using a global computer network.

26. A method as in claim 25, wherein (a) is practiced by electronically displaying a questionnaire on a computer screen connected to a global computer network, and prompting a user to input information into the questionnaire.

27. A method as in claim 23, wherein (b) is practiced to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability.

28. A method as in claim 27, wherein (b) is practiced to add additives leading to at least three or more or said enhanced features.

29. A method as in claim 23, wherein (c) is further practiced to provide a baseline motor oil of from about 50 percent to 99.9 percent of the final customized engine oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant or a blend stability additive.

30. A method as in claim 29, wherein (c) is further practiced to provide a baseline motor oil of from about 60 percent to 99.9 percent of the final customized engine oil.

31. A method as in claim 29, wherein (c) is further practiced to provide a baseline motor oil of from about 75 percent to 99.9 percent of the final customized engine oil.

32. A method as in claim 29, wherein (c) is further practiced to provide a baseline motor oil of from about 80 percent to 99.9 percent of the final customized engine oil.

34. The method of claim 1 wherein (a) – (c) are practiced using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil.

Evidence Appendix

None.

Related Proceedings Appendix

None.